Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed January 4, 2007.

I.   Summary of Examiner's Objections/Rejections

Claims 1-24 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-24.

Claim 23 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim 22 was rejected under 35 U.S.C. 112 as containing a limitation lacking sufficient antecedent basis.

Claims 1-10, 12, 14-18, and 22-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Boehme et al. (U.S. Pat. No. 6,578,191).

Claims 11 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boehme et al. in view of Cohen et al. (U.S. Pat. No. 6,011,918).

Claims 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boehme et al. in view of Stapp et al. (U.S. Publication. No. 2004/0015832).

II.   Summary of Applicant's Response

The present Reply cancels claims 22-24, amends claim 1, and adds new claim 25, leaving for the Examiner's present consideration claims 1-21 and 25. Reconsideration of the rejections is requested.

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III.   Response to Rejections

Claim 1 as amended states:

A dynamic code generation method, comprising:
        creating a class file container object;
        adding a method to the class file object;
        adding code to the method using programming language constructs;
        generating byte code for the class file container object;
        instantiating an instance of the new class file object;
        a class loader generates executable code from the byte code; and
        wherein the dynamically generated code would be configured to exist for the
life of a server it resides upon.

Claim 1 defines a dynamic code generation method. The dynamically generated code is

configured to exist for the life of a server the dynamically generated program code resides upon.

In this response, Claim 1 is amended by the features that were previously in claim 23. In

discussing claim 23, the Office Action acknowledged that Boehm does not disclose the limitation of

the "dynamically generated code would be configured to exist for the life of the server it resides

upon." The office action alleged that these features would be inherent to Boehm. However, Boehm

states "[t]he classes and objects need only exist at the time that a running application calls for the

adapter classes, and can be dynamically modified or exchanged in order to optimize the running

application or modify application functionality" (col 3, lines 4-8). By stating that the classes and

objects only need to exist when the running application calls for them, Boehm does not support the

assertion of inherent characteristic status for "the generated code would exist for the life of the

server."

Boehm does not support the Office Action's assertion of an allegedly inherent characteristic.

MPEP Section 2112, *Requirements of Rejection Based on Inherency; Burden of Proof*, provides that

"A rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical

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except that the prior art is silent as to an inherent characteristic." Yet here, Boehm is not silent, instead Boehm does not support the allegedly inherent characteristic. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action does not provide a basis in fact or technical reasoning for supporting the determination that the allegedly inherent characteristic <u>necessarily</u> flows from Boehm.

Dependent Claims 2-21 and 25 are believed to be patentable for reasons similar to those discussed above with Claim 1. It is also submitted that Claims 2-21 and 25 also add their own limitations which render them patentable in their own right. Applicant reserves the right to argue these limitations should it become necessary in the future.

Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: March 30, 2007   By: _____

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